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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,467	07/07/2003	Joseph W. Prenn	1128.017	9336
7590	03/22/2005		EXAMINER	
John L. Rogitz, Esq. ROGITZ & ASSOCIATES Suite 3120 750 "B" Street San Diego, CA 92101			YIP, WINNIE S	
			ART UNIT	PAPER NUMBER
			3637	
DATE MAILED: 03/22/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/615,467	PRENN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Winnie Yip	3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 July 2003.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-27 is/are pending in the application.  
 4a) Of the above claim(s) 12 and 21 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-11, 13-20 and 22-27 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 24 October 2003 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

This is a first office action for application Serial No. 10/615,467 filed July 7, 2003.

### ***Claim Objections***

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 25 (the claim below claim 26) has been renumbered claim 27.

### ***Election/Restrictions***

2. This application contains claims directed to the following patentably distinct species of the claimed invention: Group I, a first embodiment, shown in Fig. 2-3; Group II, a second embodiment, shown in Figs. 4-5.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claims 1 and 10 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the

limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. During a telephone conversation with Mr. Rogitz on March 7, 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-11, 13-20, and 22-25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12 and 21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Drawings***

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign mentioned in the description: "12" (see Fig. 1). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The drawings are also objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "16" has been used to designate both "roof-mounted dome" and "diffuser plate" (page 4). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 10-11 and 13-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regard to claims 10 and 19, “the shaft” (line 4 of claim 10, and line 5 of claim 19) is confusing whether or not this “shaft” is the same as the “gear train shaft”? If not, a proper antecedent basis is required.

Regard to claims 13, it is confusing what does mean by “elements of the valve” (line 4) because it will cause the claims indefinite as what “elements of the valve” that are “extending beyond the shroud” as claimed.

9. Claims 22-27 contain a phrase “means for”. However, the claim limitation falls within the scope of 36 U.S.C. 112, sixth paragraph, and a rejection under 35 U.S.C. 112, second paragraph may be appropriate.

Applicant is suggested that the specification may be amended to explicitly state what structure corresponds to the recited function with reference to the claimed terms and phrases. No new matter can be introduced.

#### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-2, 5-9, 13-15, 17-18, 22-23, and 26-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Zhang et al. (US Patent No. 6,528782).

Zhang et al. show and teach a skylight (100) comprising at least one light conveying structure (105) having an upper end covered by a dome shaped transparent cover (160) and a lower end covered by a ceiling-mounted diffuser cover (130), a shroud engaged with the light conveying structure and defining a light passageway, and the shroud having a shutter (200) mounted therein, the shutter having at least two valve elements (203) pivotable about an axle (204) within the shroud by an actuator (201) between an open configuration in which the light passageway is open, and a closed configuration in which the light is blocked, the actuator (201) actuated by either manually controlled electrical switch or automatically controlled wirelessly remove control; wherein a mechanical control (430) is either operated by a remote control (480) or simply employed by an off-on switch (456) and manually controlled rheostat (457), a power supply applies to the shutter actuator with suitable voltages either about 100V or 270V, and the shutter actuator can be an electric motor to drive a rack and pinion gear set (1310) or may be applied by electrical control circuit (see col. 24, lines 18-59, and Fig. 2a).

12. Claims 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Dayus (US Patent No. 4,628,954).

Dayus teaches a valve assembly that is capably mounted for a skylight, comprising: a shroud having a tubular configuration, an outer flange (26) extending outwardly from an outer surface of the shroud for allowing to be easily assembled to the skylight, and a lip (28) circumscribing an inner surface of the shroud, two valve elements (34, 34) pivotally mounted on a shaft (30) by axles (36, 38) respectively, the valve elements being rotated within the shroud between an open configuration to define a light passageway therethrough, and a closed configuration, wherein to block the light passageway, wherein valves engage to and supported by the lip of the shroud in the closed configuration, and the shroud having a height less than a diameter of the valve and engaging the lip in a closed configuration.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 3-4 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang et al. '782 as applied to claims 1, 13-14, and 22 above, and further in view of Dayus (US Patent No. 4,628,954).

The claims are considered to meet by Zhang et al. as explained and applied set forth above rejections except the Zhang et al. does not define the skylight having the shroud that specifically has a construction for mounting the valve elements over the shroud as claimed. Dayus teaches a shroud for mounting over a tubular housing for mounting two valves thereon for opening and closing the tubular housing in a suitable environmental conditions, wherein the

shroud having an outer flange (26) extending outwardly from an outer surface of the shroud for allowing easily to mount the shroud between two sections of the tubular housing , and the shroud having a lip (28) circumscribing an inner surface of the shroud, two valve elements (34, 34) pivotally mounted on a shaft (36, 38) respectively and engaging the lip in a closed configuration, and the shroud having a height less than a diameter of the valve. It would have been obvious to one ordinary skill in the art, at the time the invention was made, to modify the skylight of Zhang et al. having a shroud mounted on the middle portion of the skylight body and the shroud having a lip extending circumscribing an inner surfaced of the shroud and the two valves pivotally mounted height inside of the shroud driven by a shaft as taught by Dayus for providing the skylight having a shroud having a mounted mechanism to be easily assembled and having the valves being pivotally mounted thereon to be supported by the lip in the enclosed position.

***Allowable Subject Matter***

15. Claims 10-11 and 19-20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Citations***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bixby '712, Grubb '947, Chao et al. '977, and Sutton'622 teach various skylights having a plurality of sections being connected together with shrouds as similar to the claimed invention. 434. Mucha '765 teaches a skylight having an opener/or a valve element being driven by actuator having an assembly including a motor, a gear chain, and a cam connected to a shaft to operate the opener as similar to the claimed invention. McCabe '485 and Brown '316

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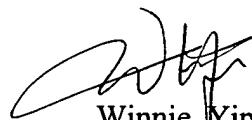
teach various valve assemblies having valve elements pivoting about a shaft within a shroud as similar to the claimed invention.

***Inquiry Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 703-308-2491 (or 571-272-6870 after April 7, 2005). The examiner can normally be reached on M-F (9:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486 (or 571-272-6867 after March 29, 2005). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Winnie Yip  
Primary Examiner  
Art Unit 3637

wsy  
March 11, 2005